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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/824,624 | 04/02/2001 | Marion R. Rice | N102US1 | 8912 |

7590 08/25/2004
Bindu R. Rao
3414 Rosefinch Trail
Austin, TX 78746

EXAMINER

ABRISHAMKAR, KAVEH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2131

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

SEP 23 2004

Technology Center 2100

Office Action Summary

Application No.

09/824,624

Applicant(s)

RICE ET AL.

Examiner

Kaveh Abrishamkar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the communication filed on April 2, 2001.
Claims 1 – 20 were received for consideration. No preliminary amendments for the claims were received. Claims 1 – 20 are currently under consideration.

Specification

2. The disclosure is objected to because of the following informalities: The wrong provisional application numbers are referenced in the specification. The correct application numbers are "60/236,128" and "60/236,228."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, and 8 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. (U.S. Patent 6,672,805).

Regarding claim 1, Brown discloses:

An authentication infrastructure comprising:

a document (Figure 1 item 102, column 7 lines 36 – 49);

a submitter client computer running a submitter function that facilitates submission of the document by a submitter (Figure 5, column 14 line 63 – column 15 line 6);

an authenticator client computer running an authenticator function that facilitates the selective authentication of a signer by an authenticator after the presentation of authentication related information by the signer (Figure 1 item 110, column 8 lines 23 – 34);

the authentication infrastructure facilitating submission of the document by the submitter via the submitter function, the subsequent signer authentication by the authenticator employing the authenticator function and the signing of the document by the signer after signer authentication (Figure 1 item 108, column 8 lines 57 – 67).

Regarding claim 11, Brown discloses:

An authentication infrastructure comprising:

an authentication network (Figure 1 item 100);

a submitter client computer, communicatively coupled to the authentication network, that facilitates document submission by a submitter (Figure 5, column 14 line 63 – column 15 line 6);

an authenticator client computer, communicatively coupled to the authentication network, that facilitates the selective authentication of a signer by

an authenticator after the presentation of authentication related information by the signer (Figure 1 item 110, column 8 lines 23 – 34); and

the authentication network facilitating document submission by the submitter via the submitter client computer, the signer authentication by the authenticator employing the authenticator client computer and the subsequent document signing by the signer after signer authentication employing the authenticator client computer (Figure 1 item 108, column 8 lines 57 – 67).

Regarding claim 18, Brown discloses:

An Internet-based authentication infrastructure comprising:

a paper document (Figure 1 item 102, column 7 lines 36 – 49);

a plurality of information items (Figure 1 item 102, column 7 lines 36 – 49);

a submitter client computer with a scanner for scanning the paper document (column 3 line 25 – column 4 line 54);

the submitter client computer facilitating the creation of a new document by the scanning of the paper document on the scanner (column 3 line 25 – column 4 line 54); and

the submitter client computer facilitating the selective specification of placement information for the plurality of information items within the new document (column 8 lines 57 – 66).

Claim 2 is rejected as applied above in rejecting claim 1. Furthermore, Brown discloses:

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The authentication infrastructure of claim 1 further comprising:

a signer computer running a signer function that facilitates viewing of the document by the signer (Figure 2 item 208, column 9 lines 42 – 46); and

the authentication infrastructure facilitating document submission by the submitter employing the submitter function, document viewing by the signer employing the signer function and signer authentication by the authenticator employing the authenticator function (Figure 1 item 102, column 7 lines 36 – 49, column 8 lines 23 – 34, column 9 lines 42 – 46).

Claim 4 is rejected as applied above in rejecting claim 1. Furthermore, Brown discloses:

The authentication infrastructure of claim 1 further comprising:

a document id for the document (column 11 lines 37 – 42);

a password associated with the document id (column 11 lines 37 – 42);

and

the authentication infrastructure providing the signer access to the document when the signer presents the document id and its associated password (column 10 lines 10 – 27, column 11 lines 37 – 42).

Claim 12 is rejected as applied above in rejecting claim 11. Furthermore, Brown discloses:

The authentication infrastructure of claim 11 further comprising:

a submitted documents that may be signed or unsigned (Figure 1 item 102, column 7 lines 36 – 49);

a signer client computer, that facilitates viewing of submitted documents (Figure 2 item 208, column 9 lines 42 – 46);

a document repository, managed by the authentication network, for storing the submitted documents and subsequently selectively retrieving them for signing (column 9 lines 35 – 42);

a status information of submitted documents that may change (Figure 2 item 208, column 9 lines 42 – 46); and

the authentication network managing the storage and retrieval of signed and unsigned submitted documents (column 9 lines 35 – 42).

Claim 14 is rejected as applied above in rejecting claim 11. Furthermore, Brown discloses:

The authentication infrastructure of claim 11 further comprising:

the authentication network facilitating a new document submission by the submitter over the Internet employing the submitter client computer and the subsequent signing of the submitted new document by the signer employing the authentication client computer over the Internet after the signer has been authenticated by the authenticator employing the authentication client computer over the Internet (Figure 5, column 14 line 63 – column 15 line 6).

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Claim 19 is rejected as applied above in rejecting claim 18. Furthermore, Brown discloses:

The Internet-based authentication infrastructure of claim 18 further comprising:

a document repository (column 9 lines 37 – 42); and

the submitter client computer saving the new document along with the specification of placement information for the plurality of information items in the new document at the document repository as a submitted document (column 9 lines 37 – 42).

Claim 3 is rejected as applied above in rejecting claim 2. Furthermore, Brown discloses:

The authentication infrastructure of claim 2 wherein the authentication infrastructure further comprising:

the authenticator function selectively requiring the authenticator to provide authentication information before facilitating the selective authentication of the signer (Figure 1 item 108, column 8 lines 57 – 67); and

the authentication infrastructure requiring the signer to authenticate himself to the authenticator by presenting authentication related information to the authenticator before allowing the signer to sign documents in the presence of the authenticator (Figure 1 item 108, column 8 lines 57 – 67).

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Claim 8 is rejected as applied above in rejecting claim 4. Furthermore, Brown discloses:

The authentication infrastructure of claim 4 further comprising:

a digital certificate installed at the authenticator client computer (column 11 lines 1 – 29, column 14 lines 18 – 62);

the digital certificate presented by the authenticator function running on the authenticator client computer for client authentication (column 11 lines 1 – 29, column 14 lines 18 – 62); and

the digital certificate employed by the authenticator function for selectively encrypting and decrypting information that are associated with the document during the signing process (column 9 lines 21 – 32, column 11 lines 1 – 29, column 14 lines 18 – 62).

Claim 9 is rejected as applied above in rejecting claim 4. Furthermore, Brown discloses:

The authentication infrastructure of claim 4 further comprising:

a server communicatively coupled to the submitter client computer running the submitter function and the authenticator client computer running the authenticator function (column 8 lines 23 – 34);

a signing party certification environment, communicatively coupled to the server, that enhances the authenticator function (column 8 lines 23 – 34);

the signing party certification environment comprising the authenticator client computer used by the authenticator to access the document from the

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server employing the authenticator function, a telephone used selectively by the signer or the authenticator to talk to the submitter of the document to determine the document id and password associated with the document, and a fax machine selectively used by the authenticator to fax a document signed by the signer to the server or to the submitter (column 3 lines 45 – 55, column 8 lines 23 – 34).

Claim 10 is rejected as applied above in rejecting claim 4. Furthermore, Brown discloses:

The authentication infrastructure of claim 4 further comprising:

a public and private key pair for the submitter (column 9 lines 21 – 31, column 11 lines 1 – 36, column 14 lines 18 – 62);

the document comprising sections for embedding electronic image signatures and associated dates along with sections for information regarding the placement of such electronic image signatures and dates (column 8 lines 57 – 66, column 13 lines 41 – 51);

the submitter function making the document secure employing the submitter's public and private key combination when the document is submitted for signing by the submitter (column 9 lines 21 – 31, column 11 lines 1 – 29, column 14 lines 18 – 62);

the authenticator function accessing the document employing the public key of the submitter to enable the signer to sign the document (column 8 lines 57 – 66); and

the authenticator function populating the sections for embedding electronic image signatures and associated dates with the signer's signature and associated signing date when the signer signs the document in the presence of the authenticator (column 8 lines 57 – 66, column 13 lines 1 – 51).

Claim 13 is rejected as applied above in rejecting claim 12. Furthermore, Brown discloses:

The authentication infrastructure of claim 12 further comprising:
the signer client computer facilitating the selective viewing of the submitted document (Figure 2 item 208, column 9 lines 42 – 46);
the submitter client computer facilitating the selective viewing the submitted documents (Figure 2 item 208, column 9 lines 42 – 46); and
the authentication network facilitating the selective storage and retrieval of the submitted documents (column 9 lines 35 – 42).

Claim 15 is rejected as applied above in rejecting claim 14. Furthermore, Brown discloses:

The authentication infrastructure of claim 14 wherein the new document is created and submitted employing the submitter client computer for signing by the signer over the Internet via the signer client computer (column 8 lines 57 – 67, column 14 line 63 – column 15 line 6).

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Claim 20 is rejected as applied above in rejecting claim 19. Furthermore, Brown discloses:

The Internet-based authentication infrastructure of claim 19 further comprising:

an authenticator client computer, communicatively coupled to the document repository, that facilitates authentication of a signer by an authenticator having access to the authentication infrastructure (Figure 1 item 110, column 8 lines 23 – 34);

the authenticator client computer facilitating the retrieval of the submitted document from the document repository (column 9 lines 37 – 42);

the authenticator client computer facilitating the selective population of the plurality of information items in the submitted document by the signer and by the authenticator after authentication of the signer by the authenticator (column 8 lines 57 – 66); and

the authenticator client computer facilitating the selective storage of the populated submitted document in the document repository (column 9 lines 35 – 42).

Claim 16 is rejected as applied above in rejecting claim 15. Furthermore, Brown discloses:

The authentication infrastructure of claim 15 wherein the submitter client computer of the authentication infrastructure further comprising:

an Internet browser-based drag-and-drop rectangular box drawing utility for drawing a rectangular box on the new document that specifies the coordinates of a one of a plurality of information items (Figure 5, column 8 57 – column 9 line 2);

the Internet browser-based drag-and-drop rectangular box drawing utility facilitating selective relocation of the rectangular box on the new document that specifies the coordinates of the one of a plurality of information items (Figure 5, column 8 57 – column 9 line 2); and

the submitter client computer facilitating the storage of the new document along with the specified coordinates of the one of a plurality of information items in the authentication network on submission of the new document by the submitter (column 9 lines 35 – 42).

Claim 17 is rejected as applied above in rejecting claim 16. Furthermore, Brown discloses:

The authentication infrastructure of claim 16 further comprising:

the authenticator client facilitating the population of the one of a plurality of information items associated with the document at the specified coordinates when the signer signs the document with the help of the authenticator via the authenticator client computer (column 8 lines 57 – 66); and

the authentication network facilitating the viewing of the signed new document by the submitter via the submitter client computer (Figure 2 item 208, column 9 lines 42 – 46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5- 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (U.S. Patent 6,671,805) in view of Smithies et al. (U.S. Patent 5,544,255).

Claim 5 is rejected as applied above in rejecting claim 4. Furthermore, Brown discloses:

The authentication infrastructure of claim 4 further comprising:

the authentication infrastructure providing the authenticator access, via the authenticator function, to the document after the authenticator submits the document id and its associated password communicated by the signer (column 10 lines 10 – 17, column 11 lines 37 – 42).

Brown does not explicitly disclose the use of a signing pad to capture a signature from a signer. Smithies disclose a system that captures handwritten signatures and appends the signature to a document (Figure 1 item 8, item 4, column 7 lines

35 – 46). Brown uses a digital signature of a user instead of the handwritten signature of a sure to sign a document. Smithies states “a “digital signature” has the function of replacing a handwritten signature” (column 3 lines 50 – 58). Both the handwritten signature and the digital signature serve the purpose of identifying a user in both inventions. Brown states “people tend to respect such traditional indicia of authenticity and non-repudiation as handwritten signatures” (column 1 lines 42 – 47). Therefore it would have been obvious to add the signature capture device disclosed by Smithies to the invention of Brown so that the people that prefer handwritten signatures would have the option of verifying a user through the use of the handwritten signature instead of a digital signature. Therefore it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to use the signature capture device of Smithies in conjunction with the system of Brown to offer the flexibility of providing either a digital signature or a handwritten signature as the indicia on the document.

Claim 7 is rejected as applied above in rejecting claim 4. Furthermore, Brown discloses:

a fax machine communicatively coupled to the authenticator function
(column 3 lines 45 – 55).

Brown does not explicitly disclose the use of a signing pad to capture a signature from a signer. Smithies disclose a system that captures handwritten signatures

and appends the signature to a document (Figure 1 item 8, item 4, column 7 lines 35 – 46). Brown uses a digital signature of a user instead of the handwritten signature of a sure to sign a document. Smithies states “a “digital signature” has the function of replacing a handwritten signature” (column 3 lines 50 – 58). Both the handwritten signature and the digital signature serve the purpose of identifying a user in both inventions. Brown states “people tend to respect such traditional indicia of authenticity and non-repudiation as handwritten signatures” (column 1 lines 42 – 47). Therefore it would have been obvious to add the signature capture device disclosed by Smithies to the invention of Brown so that the people that prefer handwritten signatures would have the option of verifying a user through the use of the handwritten signature instead of a digital signature. Therefore it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to use the signature capture device of Smithies in conjunction with the system of Brown to offer the flexibility of providing either a digital signature or a handwritten signature as the indicia on the document.

Claim 6 is rejected as applied above in rejecting claim 5. Furthermore, Brown discloses:

The authentication infrastructure of claim 5 further comprising:
an order of signing by a plurality of signers specified by the submitter;
the submitter function facilitating the specification of the order of signing
by the plurality of signers (column 10 lines 36 – 67);

the authentication infrastructure capable of selectively enforcing the order of signing by the plurality of signers (column 10 lines 36 – 67);

the authentication infrastructure enforcing the order of signing by the plurality of signers when the submitter submits a document for signing via the submitter function (column 10 lines 36 – 67).

Claim 7 is rejected as applied above in rejecting claim 4. Furthermore, Brown discloses:

a fax machine communicatively coupled to the authenticator function (column 3 lines 45 – 55).

Brown does not explicitly disclose the use of a signing pad to capture a signature from a signer. Smithies disclose a system that captures handwritten signatures and appends the signature to a document (Figure 1 item 8, item 4, column 7 lines 35 – 46). Brown uses a digital signature of a user instead of the handwritten signature of a sure to sign a document. Smithies states “a “digital signature” has the function of replacing a handwritten signature” (column 3 lines 50 – 58). Both the handwritten signature and the digital signature serve the purpose of identifying a user in both inventions. Brown states “people tend to respect such traditional indicia of authenticity and non-repudiation as handwritten signatures” (column 1 lines 42 – 47). Therefore it would have been obvious to add the signature capture device discloses by Smithies to the invention of Brown so that the people that prefer handwritten signatures would have the option of verifying a

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user through the use of the handwritten signature instead of a digital signature.

Therefore it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to use the signature capture device of Smithies in conjunction with the system of Brown to offer the flexibility of providing either a digital signature or a handwritten signature as the indicia on the document.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 703-305-8892. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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KA
08/18/04


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Notice of References Cited

Application/Control No.

09/824,624

Applicant(s)/Patent Under
Reexamination
RICE ET AL.

Examiner

Kaveh Abrishamkar

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U.S. PATENT DOCUMENTS

| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Name | Classification |
|---|---|--|-----------------|--------------------|----------------|
| | A | US-6,671,805 B1 | 12-2003 | Brown et al. | 713/176 |
| | B | US-5,544,255 A | 08-1996 | Smithies et al. | 382/119 |
| | C | US-6,757,826 B1 | 06-2004 | Paltenghe, Cris T. | 713/170 |
| | D | US-6,553,494 B1 | 04-2003 | Glass, Randal | 713/186 |
| | E | US- | | | |
| | F | US- | | | |
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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